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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,802	07/18/2005	Guenter Farin	E7900.2002/P2002	1166
24998 7590 02/16/2010 DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403				
EXAMINER				
CHEN, VICTORIA W				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/525,802

**Applicant(s)**

FARIN ET AL.

**Examiner**

VICTORIA W. CHEN

**Art Unit**

3739

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20, 21, 23-42, 44 and 47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20, 21, 23-42, 44 and 47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claim 20 is objected to because of the following informalities: lines 23-24 recite "said application". The examiner assumes this is meant to read --said applicator-- .  
Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20, 21, 23-42, 44 and 47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no written support for the new claim limitation "the inhibiting device is adapted and arranged to prevent an outlet said gas from said applicator except at an opening of the casing tube proximal to the cutting electrode", as amended in independent claims 20 and 39. While the specification does mention that the inhibiting device prevents gas leakage, there is no mention of the gas only being able to escape from an opening of the casing tube proximal to the cutting electrode, or an explanation of its criticality.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 20, 21, 23-31, 33-37, 39-42, 44 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farin (WO/98/01075) in view of Cosmescu (US 5836909).**

Regarding claims 20, 24 and 26, Farin teaches an applicator [Fig. 7a] for an electrosurgical instrument comprising a gas and high frequency current terminal [6] at a first end of the applicator, a cutting electrode [22] at a second end of the applicator, a cap [1] configured to detachably fasten the applicator on a handle of the instrument, a gas and high frequency current supply pipe [11] formed of an electrically conductive material and attached to said cutting electrode, said pipe forming a passage that communicates gas from said gas and high frequency current terminal to a location proximate to the cutting electrode [pg. 3 of Farin translation, ll. 31-34], said conducting material of said pipe conducting a high frequency current that drives said cutting electrode [pg. 2 of translation, ll. 23-28], a casing tube [20, 21, 23] displaceable relative to a common

longitudinal axis of the applicator for exposing or covering the cutting electrode [Fig. 7a, motion indicated by arrow], the casing tube surrounding the gas and high frequency current supply pipe over a longitudinal section and a collar at a distal end of casing tube [24, Fig. 7b], a path of displacement of said insulating casing tube defined by hitting contact of a collar on the casing tube with an inwardly projecting edge of a proximal extension of the insulating cap and with a portion for fastening the current supply pipe in the insulating cap [Fig. 7b, pg. 4 of translation, ll. 13-25]. However, Farin fails to specifically teach a radially surrounding gas sealing inhibiting device arranged between an inside of the casing tube and an outside of the gas and high frequency supply pipe. Cosmescu teaches an electrosurgical instrument having a casing tube [112] capable of exposing or covering a cutting electrode [130, Fig. 5a] having a radially surrounding gas-sealing inhibiting device, disclosed as an O-ring, [142] arranged in a radially surrounding groove [Fig. 5a] around the electrode so as to prevent gas from escaping and fixing the casing tube to the rest of the applicator [114, col. 11, ll. 15-24]. Therefore it would have been obvious to one of ordinary skill of the art to modify the applicator as taught by Farin with the O-ring inhibiting device as taught by Cosmescu in order to prevent gas from escaping and to allow the casing tube to be fixed to the rest of the applicator. Farin further fails to specifically teach the cap and casing tube as being insulating, however, it is apparent from the specification that the user grips the outside of the cap and casing tube [Farin translation, pg. 2, ll. 29-32], therefore it would have been obvious to one of ordinary skill that the cap and casing tube are insulated in order to protect the hands of the user.

Regarding claim 21, Farin in view of Cosmescu teach the invention as claimed, but fail to specifically teach the inhibiting device located in a portion of the proximal extension of the insulating cap. It is noted that applicant's specification fails to provide any criticality and/or unexpected result associated with the claimed location of the inhibiting device. Therefore the examiner maintains that one of ordinary skill in the art would obviously recognize that any reasonable placement wherein the inhibiting device provides fixing and sealing properties may be used to achieve the desired results.

Regarding claims 23, Farin teaches a hollow cylindrical partially outwardly projecting insert [10, Fig 2a] arranged at a proximal outer end of casing tube.

Regarding claim 25, Farin in view of Cosmescu teaches the invention as claimed, including a radially surrounding groove for accommodating the inhibiting device on the gas and high frequency current supply pipe, but fail to teach the groove located on the casing tube. It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the groove as taught by Farin in view of Cosmescu by putting it on the casing tube instead of the supply pipe because Applicant has not disclosed that the groove on the casing tube provides an advantage, is used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the groove located on the supply pipe as taught by Farin in view of Cosmescu, because it provides frictional locking means and since it appears to be an arbitrary design consideration which fails to patentably distinguish over Farin in view of Cosmescu. Therefore, it would have been an obvious matter of design choice to put the groove on the casing tube to obtain the invention as specified in the claim(s).

Regarding claim 27, Farin teaches the collar [24] at the distal end of the casing tube effect, in conjunction with a cylindrical inner recess of the insulating cap extension, an additional radial and axial guidance for the casing tube [Fig. 7b].

Regarding claim 28, Farin teaches the casing tube having an external right-angle bend [Fig. 7b] comprising a groove [26] for accommodating an additional inhibiting device [27].

Regarding claim 29, Farin teaches the invention as claimed, including an inhibiting device which assists in fixing the casing tube to the applicator, but fails to teach the inhibiting device being an elastic sealing ring. Cosmescu teaches using an elastic sealing means as an inhibiting device to prevent gas from escaping and fixing the casing tube to the rest of the applicator. It would have been obvious to one of ordinary skill in the art to substitute the inhibiting device as taught by Farin with an elastic ring as taught by Cosmescu to achieve the predictable result of fixing the casing tube to the applicator, and furthermore providing the advantage of preventing gas from escaping.

Regarding claim 30, Farin teaches the insulating cap [1] has the shape of a truncated cone [Fig. 7b] and a cap closing piece [27] located in a hollow cylindrical recess of the upper surface of the truncated cone.

Regarding claim 31, the cap closing piece can be interpreted as a proximal extension of the insulating cap [Fig. 7b].

Regarding claim 33, Farin teaches the distal end of the casing tube is guided and retained by the cap closing piece [pg. 4 of translation, ll. 13-25].

Regarding claim 34, Farin teaches the invention as claimed, including the insert [10] being an insulator [pg. 5 of translation, ln. 3], but fails to specifically teach the insert being made of ceramics. However, it is commonly known in the art to use ceramics as the material for a nozzle insulator in gas assisted electrosurgical applicators, as shown by Goble et al. (US 6491690 B1) [20, Fig. 7, col. 9, ll. 34-37] and Fleenor (US 5306238) [15, Fig. 2, col. 5, ll. 63-65]. Therefore, it would have been obvious to make the insert out of ceramic, since it is commonly known in the art.

Regarding claim 35, Farin teaches the cutting electrode [22] is attached at a proximal end of an inside of the gas and high frequency current supply pipe [Fig. 7a, via element 4 as seen in Fig. 2a].

Regarding claims 36 and 37, Farin teaches the cutting electrode comprises a fastening support pipe [unlabeled element surrounding 22 in Fig. 7a, labeled as 10 in Fig. 2a] at its distal end which adjusts the electrode coaxially within [Fig. 7a].

Regarding claims 39 and 41, Farin teaches an applicator for an electrosurgical instrument comprising a supply pipe [11] formed of an electrically conductive material, an electrode [22] attached to supply pipe, a member [23, 21, 20], in the form of a tube [Fig. 7a], configured to surround a longitudinal section of the supply pipe, a cap [1] configured to detachably fasten the applicator on the handle of the instrument, said pipe forming a passage that communicates gas flow [pg. 3 of Farin translation, ll. 31-34], said conducting material of said pipe conducting a high frequency current that drives said electrode [[pg. 2 of translation, ll. 23-28]], said insulating member configured for displacement relative to said supply pipe in the direction of a longitudinal axis of said



supply pipe [Fig. 7a, direction of arrows], said cap configured to cooperate with said member to limit said displacement of the member relative to the supply pipe [Fig. 7b, pg. 4 of translation, ll. 13-25]. However, Farin fails to specifically teach a radially surrounding gas sealing inhibiting device arranged between an inside of the member and an outside of the supply pipe. Cosmescu teaches an electrosurgical instrument having a casing tube [112] capable of exposing or covering a cutting electrode [130, Fig. 5a] having a radially surrounding gas-sealing inhibiting device, disclosed as an O-ring, [142] arranged in a radially surrounding groove [Fig. 5a] around the electrode so as to prevent gas from escaping and fixing the casing tube to the rest of the applicator [114, col. 11, ll. 15-24]. Therefore it would have been obvious to one of ordinary skill of the art to modify the applicator as taught by Farin with the O-ring inhibiting device as taught by Cosmescu in order to prevent gas from escaping and to allow the casing tube to be fixed to the rest of the applicator. Farin further fails to specifically teach the cap and member as being insulating, however, it is apparent from the specification that the user grips the outside of the cap and casing tube [Farin translation, pg. 2, ll. 29-32], therefore it would have been obvious to one of ordinary skill that the cap and casing tube are insulated in order to protect the hands of the user.

Regarding claim 40, Farin teaches the insulating member is displaceable relative to a common longitudinal axis of the applicator for exposing or covering the electrode [Fig. 7a].

Regarding claim 42, Cosmescu teaches the seal [142] is a fluid proof seal [col. 11, ll. 15-24].

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Regarding claim 44, Farin teaches the supply pipe [11] extends through said insulating cap [Fig. 7b].

Regarding claim 47, Farin teaches the electrode [22] is connected to the supply pipe [11] via an inner surface of the supply pipe [Fig. 7a, via unlabeled element labeled as 4 in Fig. 2a].

**Claims 32 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farin (WO/98/01075) in view of Cosmescu (US 5836909), as applied to claim 30 above, in further view of von Dyck et al. (US 2002/0077611 A1).**

Farin in view of Cosmescu teach the invention as claimed, except fail to teach the cap closing piece including an internal collar or being integrally connected to the hollow cylindrical recess of the cap. Farin teaches that the cap closing piece [27] in addition to an annular recess located on the casing tube [26, Fig. 7b] is present in order provide predetermined rest positions for the casing tube relative to the insulating cap [Farin translation, pg. 4, ll. 21-25]. von Dyck teaches use of a securing assembly for a medical instrument comprising an integral annular collar [136], the collar and a recess assembly [140], order to provide a predetermined secure, leak-free connection which prevents inadvertent detachment of two selectively attachable tubular elements [par. 0057]. It would have been obvious to one of ordinary skill to substitute the securing assembly as taught by Farin in view of Cosmescu for the assembly as taught by von Dyck to achieve the predictable result of providing predetermined secure rest positions for the casing tube relative to the insulating cap, and further to provide the advantage of preventing inadvertent detachment of the two elements.

***Response to Arguments***

Applicant's arguments filed 11/23/09 have been fully considered but they are not persuasive.

Applicant amended independent claims 20 and 39 to incorporate the claim limitation that the inhibiting device is adapted to prevent outlet of the gas from the applicator except at an opening of the casing tube proximal to the cutting electrode. However, upon inspection of applicant's specification, there is no written support for the specific limitation; while the specification does mention that the inhibiting device prevents gas leakage, there is no mention of the gas only being able to escape from an opening of the casing tube proximal to the cutting electrode. The specification is silent as to the available outlets for the gas, and the only support that the examiner can gather that the inhibiting device is able to perform the amended limitation is from looking at the figures, since applicant's invention lacks any other possible outlets. Applicant argues that the Cosmescu reference fails to teach the inhibiting device arranged and adapted to prevent the outlet of the gas from the applicator except at an opening of the casing tube proximal to the cutting electrode because the Cosmescu reference shows a suction/irrigation adaptor [62] having ports [70, 72] which is capable of being used with the embodiment as shown in Fig. 5B. However, Cosmescu clearly teaches that the adaptor does not have to be used with the electrode device [col. 11, ll. 33-37], and it is the examiner's position that the adaptor has no effect on the performance and purpose of the inhibiting device, which is to prevent gas from escaping and fixing the casing tube to the rest of the applicator, as stated in the above rejection.

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Moreover, the Cosmescu reference is a modifying reference applied in conjunction with Farin (WO/98/01075). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It can be seen that the Farin invention also lacks any other outlets, and as such, the combination of the inhibiting ring as taught by Cosmescu with the applicator of Farin would result in a sealing member adapted and arranged to prevent outlet of the gas from the applicator except at an opening of the casing tube proximal to the cutting electrode.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTORIA W. CHEN whose telephone number is (571)272-3356. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victoria W Chen/  
Examiner, Art Unit 3739

/Michael Peffley/  
Primary Examiner, Art Unit 3739